

REMARKS

Claims 1-3 and 5-9 are all the claims pending in the application.

At page 2 of the Action, the amendment to the specification made in the Amendment filed October 15, 2003, is objected to as allegedly introducing new matter. At page 3 of the Action, claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Applicants respectfully traverse the objection and the rejection. Applicants wish to point out that the amendments to the specification and the claims to correct the structural formula are supported by the original specification, in particular, in the working examples.

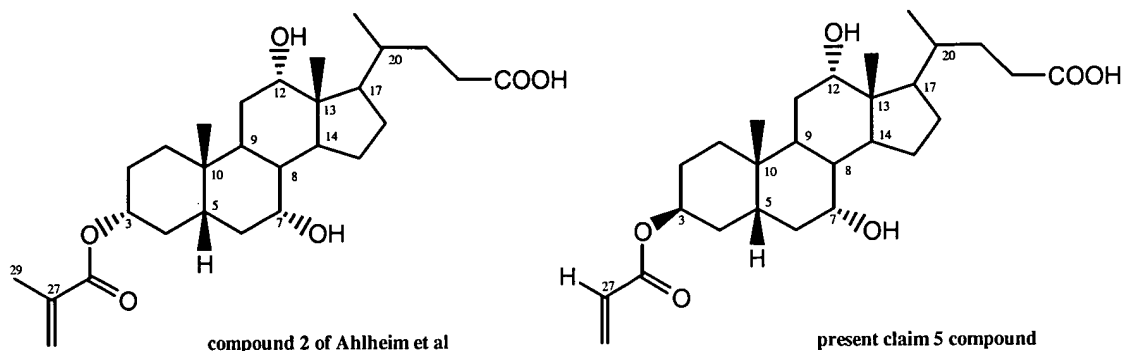
Specifically, each of the compounds in Examples 1-8 was synthesized from cholic acid or its derivative having the 5 β -cholanic acid skeleton. Accordingly, one skilled in the art would easily recognize the existence of error and the appropriate correction.

Regarding the proviso that "R₃ represents a hydrogen atom when R₁ and R₂ each represents a hydroxyl group," as recited in present claim 1, Applicants wish to point out that this amendment is supported, for example, by claim 5.

During the Interview of May 12, 2004, the Examiner agreed that the amendments to the specification and the claims are not new matter, and thus decided to withdraw the objection and rejection.

At page 5 of the Action, claim 1 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ahlheim et al. (Makromol. Chem. 193(3), p. 779-797).

Applicants respectfully traverse the rejection. Applicants wish to point out that there are two differences between the present claim 5 compound and compound 2 of Ahlheim et al, i.e., R₃ being hydrogen instead of methyl and the opposite configuration at the C-3 position. See also page 7 of the Amendment under 37 C.F.R. § 1.116 filed May 14, 2003.



Applicants have established the patentability of the present invention, by the evidence submitted in the form of a Declaration under 37 C.F.R. § 1.132, and the Remarks in the Amendment of May 14, 2003, with regard to the difference in configuration at the 3-position between the presently claimed compound and the compound disclosed in Ahlheim et al, and the difference in results.

Specifically, the results in the Declaration clearly show that the monomer compound of the present invention can be polymerized to obtain a resin and enables one to control the molecular weight of the resin. In contrast, the compound of Ahlheim et al, which has a different structure from the monomer compound of the present invention, cannot be polymerized and a resin cannot be obtained.

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Further, Applicants submit that the configuration at the 3-position has a significant effect on the reactivity of the compounds. The reactivity of the 3 α -hydroxymethacrylate ester in Ahlheim et al differs greatly from the reactivity of the 3 β -hydroxyacrylate ester and 3 β -hydroxymethacrylate ester in the present invention. See pages 11 to 12 of the Amendment filed October 15, 2003.

During the Interview of May 12, 2004, the Examiner agreed that the present invention provides unexpectedly superior results and is patentable over the cited reference, and thus decided to withdraw the rejection.

At page 6 of the Action, claims 2-3 and 5-9 are objected to as being dependent upon the rejected base claim 1.

Applicants respectfully submit that the objection should be withdrawn because the rejections of claim 1 have been overcome as set forth above.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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